

## **REMARKS/ARGUMENTS**

### **Claim Amendments**

By the present amendment, claim 1 has been amended to include within the definition of  $R^3$ , the expression "and  $-\text{CH}_2\text{-C}\equiv\text{C-R}^6$ , in which  $R^6$  is selected from the group consisting of H, aryl,  $\text{C}_{1-10}$ alkyl,  $\text{C}_{2-10}$ alkenyl,  $\text{C}_{2-10}$ alkynyl,  $\text{C}_{3-10}$ cycloalkyl and  $\text{C}_{3-10}$ cycloalkenyl, which latter six groups are optionally substituted". Support for this amendment is found, for example, in claim 2.

Claim 1 has also been amended to remove the possibility that  $R^1$  and  $R^2$  are linked together to form an optionally substituted ring.

Claim 1 has further been amended to include optional substituents for the variables  $R^3$  and  $R^6$ . Support for  $R^3$  having optional substituents can be found, for example, at page 6, lines 11-13 of the application as originally filed. Support for  $R^6$  having the same optional substituents can be found, for example, in claim 2.

Claim 1 has also been amended to delete the repeated definitions for  $R^1$ ,  $R^2$  and  $R^3$  to correct an obvious clerical error.

Finally, claim 1 has been amended to include the expression "one or more of the carbon atoms in the alkyl, alkenyl and/or alkynyl groups of  $R^1$ ,  $R^2$  and/or  $R^3$  is optionally replaced with a heteroatom selected from the group consisting of O, S, N, O and Si, which, where possible, is optionally substituted with one or more  $\text{C}_{1-6}$ alkyl groups; said process comprising the steps of reacting imines of Formula (I) in the presence of  $\text{H}_2$ , a base and a catalytic system in which the catalytic system includes a base and a ruthenium complex comprising (1) a diamine and (2) a diphosphine ligand or monodentate phosphine ligand." Support for this amendment can be found, for example, at page 6, lines 14-21 of the application as originally filed.

Claims 2, 4 and 20-24 have been cancelled without prejudice.

Claim 25 has been amended to change its dependency from claim 20 to claim 1 in light of the cancellation of claim 20. This amendment does not alter the scope of this claim in any way.

Claims 28 and 30 have been amended to change their dependency from claim 20 to claim 25 in light of the cancellation of claim 20. This amendment does not alter the scope of this claim in any way.

Claims 28-31 have been amended to delete the reference to the variables  $R^4$  and  $R^5$  in light of the cancellation of claim 2.

Claims 54-56 have been cancelled as being directed to non-elected subject matter.

The claim amendments have been made without prejudice and without acquiescing to any of the Examiner's objections. The Applicants submit that no new matter has been entered by the present amendment and entry of the amendments is respectfully requested. The Applicants reserve the right to file any of the cancelled subject matter in a divisional patent application.

The Official Action dated November 30, 2007 has been carefully considered. It is believed that the claims submitted herewith and the following comments represent a complete response to the Examiner's comments and place the present application in condition for allowance. Reconsideration is respectfully requested.

### **35 USC §112**

The Examiner has rejected claim 1 under 35 USC §112 as the claimed recitation of a process of making an amine from an imine, without setting forth any steps involved in the process, results in an improper definition of a process. The Applicant traverses this rejection for the reason that follows.

By the present amendment, claim 1 has been amended to include the process limitation, "said process comprising the steps of reacting imines of Formula (I) in the presence of H<sub>2</sub>, a base and a catalytic system in which the catalytic system includes a base and a ruthenium complex comprising (1) a diamine and (2) a diphosphine ligand or monodentate phosphine ligand." Support for this amendment can be found at least at page 6, lines 14-21 of the application as originally filed. Consequently, the Applicant submits that claim 1 is no longer indefinite, as a process step is now included within claim 1.

In light of the above, the Applicant requests that the Examiner's rejection of claim 1 under 35 USC §112 be withdrawn.

The Examiner has rejected claim 2 under 35 USC §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter. As claim 2 has been cancelled, the Examiner's objection has been rendered moot.

In light of the above, the Applicant requests that the Examiner's rejection of claim 2 under 35 USC §112 be withdrawn.

### **35 USC §102(b)**

The Examiner has rejected claim 1 under 35 USC §102(b) as being anticipated by Cobley et al. (US Pat. No. 6,528,687, hereinafter Cobley).

By the present amendment, claim 1 has been amended to remove the possibility that R<sup>1</sup> and R<sup>2</sup> are linked together to form an optionally substituted ring. As the variables R<sup>1</sup> and R<sup>2</sup> can no longer be linked to form a ring, the Applicant submits that Cobley does not anticipate claim 1, and the Examiner's rejection has been rendered moot.

In light of the above, the Applicant requests that the Examiner's rejection of claim 1 under 35 USC §102(b) as being anticipated by Cobley be withdrawn.

The Examiner has rejected claim 1 under 35 USC §102(b) as being anticipated by Tararov et al. (Phosphines versus phosphinites as ligands in the rhodium catalyzed asymmetric hydrogenation of imines a systematic study, Tetrahedron: Asymmetry, 10(20), 4009-4015, 1999, hereinafter Tararov).

By the present amendment, claim 1 has been amended to include the optional substituents for the variable  $R^3$ . Tararov discloses the hydrogenation of a N-(1-phenylethylidene)benzylamine, which possesses a benzyl group at the  $R^3$  position. As the optional substituents of  $R^3$  do not include a phenyl group, the Applicant submits that the Examiner's rejection has been rendered moot.

In light of the above, the Applicant requests that the Examiner's rejection of claim 1 under 35 USC §102(b) as being anticipated by Tararov be withdrawn.

### **35 USC §103(a)**

The Examiner has rejected claims 1-4 under 35 USC §103(a) as being obvious in light of Cobley.

The Applicant notes that the Examiner did not object to claim 5, which claims the process of claim 1, when  $R^1$  is an optionally substituted aryl group. By the present amendment,  $R^1$  and  $R^2$  can no longer be linked to form a ring, and therefore  $R^1$  in claim 1 has been restricted to aryl or heteroaryl. Consequently, the Applicant submits that Cobley does not render obvious claim 1, or claim 3 which is dependent upon claim 1. Further, as claims 2 and 4 have been cancelled, the Applicant submits that the Examiner's rejection has been rendered moot.

In light of the above, the Applicant requests that the Examiner's rejection of claims 1-4 under 35 USC §103(a) as being obvious in light of Cobley be withdrawn.

### **Double Patenting**

The Examiner has rejected claims 2-53 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 7,256,311 (hereinafter '311).

The Applicant submits that as claimed 2, 4 and 20-24 have been cancelled, the embodiment which resulted in the double-patenting rejection has been deleted from the claims. The Applicant notes that claim 1 was not rejected because R<sup>1</sup> must be an aryl or heteroaryl group, which was not disclosed in the '311 patent, and therefore, is not rendered obvious in light of the '311 patent. As all of the remaining claims are dependent upon claim 1, the Applicant submits that the Examiner's rejection has been rendered moot.

In light of the above, the Applicant requests that the Examiner's rejection of claims 2-53 on the ground of nonstatutory obviousness-type double patenting be withdrawn

The Commissioner is hereby authorized to charge any fee (including any claim fee) which may be required to our Deposit Account No. 02-2095.

Appl. No. 10/596,489  
Response dated February 22, 2008  
Reply to Office action of November 30, 2007

In view of the foregoing comments and amendments, we respectfully submit that the application is in order for allowance and early indication of that effect is respectfully requested. Should the Examiner deem it beneficial to discuss the application in greater detail, he is invited to contact the undersigned by telephone at (416) 957-1665 at his convenience.

Respectfully submitted,

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